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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,396	09/30/2005	David Wolf	WOLF 19.787(100616-00057)	6055
26304	7590	05/05/2006	EXAMINER REHM, ADAM C	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			ART UNIT 2875	PAPER NUMBER

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/524,396

Applicant(s)

WOLF ET AL.

Examiner

Adam C. Rehm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-18 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. <u>4/20/06</u> .                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/10/2005</u> .   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Election/Restrictions*

The inventions are distinct, each from the other because of the following reasons:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-18, drawn to a pivotable light fixture, classified in class 362, subclass 364.
  - II. Claim 19-22, drawn to a firebox for containing a light fixture, classified in class 52, subclass 27.
2. The inventions are distinct, each from the other, because of the following reasons:
3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The subcombination has separate utility.
5. During a telephone conversation with attorney of record, Mr. Shakir, on April 20, 2006, a provisional election was made without traverse to prosecute the invention of I, Claims 1-18. As such, Claims 19-22 are withdrawn from further consideration by the Examiner. 37 CFR 1.142(b) as being drawn to a non-elected invention.

***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

- 1) Said pin extending below said flange prior to assembly of said ceiling plate per at least Claim 6.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites the limitations "said unexposed surface" in Line 2 and "said support position" in Line 2. There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by JAMISON ET AL. (US 6,461,016), which discloses a light fixture for installation in a ceiling (10) comprising:

- A can (22) positioned adjacent a junction box (18), said can having a first end substantially positionable in said ceiling and a second end having a flange adjacently positionable against an exposed surface of the ceiling about an orifice in said ceiling which said can extends (Figs. 7, 8 and 15);
- A lighting unit removable engageable with said junction box (32, Fig. 8);

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- Sole retaining means for retaining said can in said ceiling, disposed on said can, accessible through said can from the exposed surface and adapted for clamping engagement against said exposed surface (82, Figs. 8 and 9);
- A ceiling plate member rotatably removably and securely engageable with said flange to provide an exterior trim to the light fixture (Fig. 8 illustrates trim element 146 of 20; Figs. 10 and 11 illustrate rotating engagement element 162 of 20); and
- A reflector having an ellipsoidal geometry that is removably engageable with said can and capable of producing a lighting efficiency of at least 84% (20, Figs. 10 and 11 illustrate removable nature).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over JAMISON ET AL. (US 6,461,016) as applied to claim 1 above, and further in view of LIBERMAN (US 3,778,609). JAMISON discloses the claimed invention, but does not disclose a light unit that pivots from a first, angled position relative to a junction box to a second, substantially horizontal position. However, while pivoting light units are notoriously

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known in the art, JAMISON teaches a pivoting light unit (23, Fig. 4) for the purpose of providing an adjustable recessed lamp (Column 1, Lines 10-26).

10. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify JAMISON and use the adjustable lamp as taught by LIBERMAN in order to provide a lamp with increased versatility.

11. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JAMISON ET AL. (US 6,461,016) and LIBERMAN (US 3,778,609) in view of DASHER (US 2,816,216). JAMISON and LIBERMAN substantially disclose the claimed invention including a pivoting lamp unit (LIBERMAN 23), but do not disclose: (1) a lighting unit that pivots under gravity in response to the detachment of a ceiling plate to a flange per Claims 3 and 4; or (2) a pin extending below said flange prior to assembly and attached to a socket holder for controlling the positioning of the lighting unit per Claims 5 and 6. However, DASHER teaches a pin assembly that connects a flange to a ceiling plate (20, Fig. 2) that controls the pivoting of a socket holder (6/24, Fig. 2) for the purpose of controlling the positioning of the lighting unit (Column 1, Line 72-Column 2, Line 6).

12. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify JAMISON and use the pin assembly as taught by DASHER in order to provide simplified mechanical means for allowing a lighting unit to pivot, thus providing a light unit with increased versatility.

13. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JAMISON ET AL. (US 6,461,016) in view of WOLF ET AL. (US 6,457,848). JAMISON discloses the claimed invention, but does not disclose retaining members disposed on

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said flange and movable from an insertion position lying adjacent said can for installation to a support position extending outwardly from said can to support the can. However, WOLF teaches retaining members (36) that operate as claimed for the purpose of simplified installation of a light unit (Column 5, Lines 19-52).

14. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify JAMISON and use the retaining members as taught by WOLF in order to provide simplified installation of a light unit.

15. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over JAMISON ET AL. (US 6,461,016) in view of CHAN ET AL. (US 5,222,800). JAMISON discloses the claimed invention, but does not disclose hanger supports integrally formed into said junction box for receiving support hangar bars for attaching said light fixture to a ceiling. However, CHAN teaches hangar supports (59) for the purpose of mounting a light fixture to a ceiling (column 7, Lines 1-33).

16. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify JAMISON and use the hangar bars as taught by CHAN in order to support a light fixture.

17. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JAMISON ET AL. (US 6,461,016) in view of applicant's admitted prior art. JAMISON discloses the claimed invention, but does not specify whether the light unit is airtight or has air vents. However, applicant admits that it is known and subject to regulations to manufacture light units that are airtight or having air vents for the purpose of energy conservation.



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18. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify JAMISON and use an airtight light unit as taught by applicant in order to provide optimal disposal of energy.

19. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over JAMISON ET AL. (US 6,461,016). JAMISON discloses the claimed invention including a reflector (20) and junction box (32), but does not disclose a reflector that is integral with a junction box. However, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involved only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

20. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify JAMISON and use an integral reflector and junction box for the purpose of increasing ease of assembly.

21. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over JAMISON ET AL. (US 6,461,016) in view of WOLF ET AL. (US 6,457,848).

JAMISON discloses the claimed invention, but does not disclose a ballast slideably attachable inside a junction box. However, WOLF teaches a ballast (118) slideably attachable inside a junction box (Fig. 2) for the notoriously known purpose of regulating electricity to fluorescent/discharge lamps.

22. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify JAMISON and use the ballasts as taught by WOLF in order to regulate a fluorescent/discharge bulb.

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***Allowable Subject Matter***

23. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

24. The following is a statement of reasons for the indication of allowable subject matter: no prior art of record discloses or otherwise suggests a lighting fixture with a pin as claimed with emphasis on "...a pin attached to said socket holder...said pin extend[ing] below said flange prior to assembly...said ceiling plate contact[ing] said pin during attachment of said ceiling plate with said flange and caus[ing] said lighting unit to pivot..."

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- 25. PELTON (US 6,779,910) discloses a pivotable light fixture.
- 26. TARGETTI (US 5,609,408) discloses an adjustable lighting apparatus.
- 27. DRUFFEL ET AL. (US 4,947,297) discloses a pivotable light fixture.
- 28. DUCHENE ET AL. (US 2,998,512) discloses a pivotable light fixture.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam C. Rehm whose telephone number is 571.272.8589. The examiner can normally be reached on M-F 9-5:30 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571.272.2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ACR

4/20/2006

A handwritten signature in black ink, appearing to read 'T. Sember', with a long horizontal line extending to the right.

**THOMAS M. SEMBER  
PRIMARY EXAMINER**